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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,928	04/14/2000	Thierry Delplanche	32232-159912	8898

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EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 08/08/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/549,928

Applicant(s)

DELPLANCHE ET AL.

Examiner

Margaret B. Medley

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,15,16,26 and 35-58 is/are pending in the application.
- 4a) Of the above claim(s) 1-5,15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35,36,41,42,44,47-52 and 56-58 is/are rejected.
- 7) ☒ Claim(s) 26,37-40,43,45,46,53 and 54 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to Paper No. 18 dated May 5, 2003.

The amendment canceling claims 8-14, 17-25 and 27-34 and adding claims 35-58 has been entered of record.

The pending claims of record are claims 1-7, 15-16, 26 and 35-58.

Claims 1-7 and 15-16 are drawn to the non-elected invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 46, 47, 54 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The "Y" component in claims 46, 47, 54 and 55 lack supports in claim 35 and 51, which do not contain a "Y", component.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35-36, 41-42, 44 and 48-40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gary et al "Preparation and Properties of Some Alpha Azo-amino-acid Derivatives, Their Possible Use in Peptide Synthesis", note compound 5 of page

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741, column 1, lines 6⁺ for "2, 4-dinitrophenyloxycarbonyl phenyl alanine" which anticipates the instant claimed reagents.

Claims 35-36, 41-42, 44 and 48-50 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ryono et al 4,885,292.

Note column 35, lines 47-59 for a solution comprising N- [(4-Nitrophenoxy) carbonyl]-L-phenyl alanine, methyl ester that clearly anticipates the instant claimed compounds and solution comprising said compounds

Claims 35-36, 41-42, 44 and 48-50 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Patel 5,217,958.

Note column 22 for compounds LXIV and LXVIII and column 82 lines 255-25 for the compound A. for N- [(4-Nitrophenoxy)carbonyl]-L-phenyl alanine, methyl ester and a solution containing said compound that clearly anticipates the instant claimed compounds and solutions comprising said compounds.

Claims 35-36, 41-42, 44 and 48-50 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Norbeck et al 5,461,067.

Note column 33, lines 15-28 for the compound D.N-(((4-Nitrophenyl)oxy)carbonyl)-L-valine Methyl Ester and solution comprising said compound that clearly anticipates the compound and solution comprising said compound of the instant claims.

Claims 35-36, 41-42, 44 and 48-50 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by AL-RAZZAK et al (AL-RAZZAK) 5,484,801.

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Note column 17, line 55-end for compound R.N-(((4-Nitrophenyl)oxy)carbonyl)-L-valine Methyl Ester and solution comprising said compound that clearly anticipates the instant claimed compound and solution comprising said compound.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 51-52 and 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gary et al "Preparation and Properties of Some Alpha Azo-amino-acid Derivatives, Their Possible Use in Peptide Synthesis", note compound 5 of page 741, column 1, lines 6* for "2, 4-dinitrophenyloxycarbonyl phenyl alanine" which render obvious the instant claimed reagents.

The instant claims are directed to the thio analog of Gary et al compounds. It would be obvious to the artisan in the art with teachings to the compounds of Gary to prepare its thio analog compounds rendering the instant claims obvious.

Claims 51-52 and 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Ryono et al 4,885,292.

Note column 35, lines 47-59 for a solution comprising N-[(4-Nitrophenoxy)carbonyl]-L-phenyl alanine, Methyl ester that renders obvious the instant claimed compounds and solution comprising said compounds.

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The instant claims are directed to the thio analog of Ryono et al compounds. It would be obvious to the artisan in the art with teachings to the compounds of Ryono to prepare its thio analog compounds rendering the instant claims obvious.

Claims 51-52 and 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel 5,217,958.

Note column 22 for compounds LXIV and LXVIII and column 82 lines 5-25 for the compound A. N-[(4-Nitropohenoxy)carbonyl]-L-phenyl alanine, Methyl ester and a solution containing said compound that render obvious the instant claimed compounds and solutions comprising said compounds.

The instant claims are directed to the thio analog of Patel compounds. It would be obvious to the artisan in the art with the teachings to the compounds of Patel to prepare its thio analog compounds rendering the instant claims obvious.

Claims 51-52 and 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norbeck et al 5,461,067.

Note column 33 lines 15-28 for the compound D.N-(((4-Nitrophenyl)oxy)carbonyl)-Lvaline Methyl Ester and solution comprising said compound that render obvious the compound and solution comprising said compound..

The instant claims are directed to the thio analog of Norbeck compounds. It would be obvious to the artisan in the art with the teachings to the compounds of Norbeck to prepare its thio analog compounds rendering the instant claims obvious.

Claims 51-52 and 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over (AL-RAZZAK et al (AL-RAZZAK) 5,484,801.

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Note column 17, line 55-end for compound R.N-(((4-Nitrophenyl)oxy)carbonyl)-L-valine, Methyl Ester and solution comprising said compound that render obvious the claimed compound and solution comprising said compound.

The instant claims are directed to the thio analog of AL-RAZZAK compounds. It would be obvious to the artisan in the art with teachings to the compounds of AL-RAZZAK to prepare its thio analog compounds rendering the instant claims obvious.

Claims 37-40, 43, 45-45 and 53-54 appear to contain allowable subject matter and would be allowed if the dependent claims were written in independent claim format including all of the limitation of its intervening claims. Instant claims 37-40, 43, 43-45 and 53-54 are objected to for containing allowable subject matter.

The restriction requirement previously made of record is maintained as being proper for reasons made of record in Paper No. 4 dated April 9, 2001.

Applicant's arguments with respect to claims 26 and 35-58 are have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art cited but not applied further teaches compounds and/or reagents of the same nature as claimed by applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday--Friday from 7:30 a.m. to 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


MARGARET MEDLEY
PRIMARY EXAMINER

M.B. Medley/dh
August 7, 2003